



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,730	10/27/2003	Jian Ni	PF293D2	9711

22195 7590 11/01/2006

HUMAN GENOME SCIENCES INC.
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE, MD 20850

EXAMINER

JIANG, DONG

ART UNIT	PAPER NUMBER
----------	--------------

1646

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/692,730

Applicant(s)

NI ET AL.

Examiner

Dong Jiang

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-90 is/are pending in the application.
- 4a) Of the above claim(s) 17, 18, 42, 59, 60 and 84 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16 and 19-41 is/are allowed.
- 6) ☒ Claim(s) 43-58, 61-83 and 85-90 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-90 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/27/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED OFFICE ACTION

Applicant's election with traverse of Group I invention, claims 1-16, 19-41, 43-58, 61-83 and 85-90, filed on 06 August 2006 is acknowledged. The traversal is on the ground(s) that Groups I and II are related as product and process of using; that the search of Group I would significantly overlap, if not be co-extensive with, the search of Group II; and thus, the search and examination of Groups I and II together would not entail a serious burden. This is not found persuasive because, although, as indicated by applicants, any search of the prior art in regard to group I may reveal whether any prior art exists as to the other Groups ("overlap"), a search is aimed to find references which would render the invention obvious, as well as references directed to anticipation of the invention. Therefore, a search for one group is not adequate as to revealing references anticipating the other groups. Thus, independent searches of relevant literature in different areas of subject matter are required for different groups, which constitute undue burden. Further, as clearly indicated by the examiner in the last Office Action, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04.

The requirement is still deemed proper and is therefore made FINAL.

Currently, claims 1-90 are pending, and claims 1-16, 19-41, 43-58, 61-83 and 85-90 are under consideration. Claims 17, 18, 42, 59, 60 and 84 are withdrawn from further consideration as being drawn to a non-elected invention.

Formal Matters:

Information Disclosure Statement

Applicant's IDS submitted on 10/27/2003 is acknowledged and has been considered. A signed copy is attached hereto. Note, since the sequences from Genbank or other databases cited on the information disclosure statement (AC-BU) are not true publications with a publication date, they are not fully in compliance with 37 CFR 1.97, and thus they will not be printed on the face of the patent issuing from this application.

Art Unit: 1646

Priority acknowledgement

This application claims benefit of U.S. applications 09/317,641 filed on 5/25/99 and 08/916,442 filed on 8/22/97, and U.S. provisional application 60/024,348, filed on 8/23/96, which is acknowledged.

Specification

Title

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the elected claims are directed.

Rejections under 35 U.S.C. 112:

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 85-90 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 85 is indefinite for the recitation "specifically binds a T1R-like ligand II protein ..., said cell comprising a polynucleotide encoding ... SEQ ID NO:2" because it is unclear whether "a T1R-like ligand II protein" is the same as SEQ ID NO:2.

The remaining claims are included in this rejection because it is dependent from the specifically mentioned claims without resolving the indefiniteness issue belonging thereto.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 43-58 and 61-83 are further rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

Art Unit: 1646

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 43 61 and 69 recite a deposited cDNA clone, ATCC 97655, which encodes said protein of SEQ ID NO:2. However, the specification fails to provide the deposit statement indicating the deposit material will be readily available to the public without restriction upon issuance of the patent. Such statement would satisfy the enablement requirement of 35 U.S.C. 112. For each deposit made pursuant to these regulations, the specification shall contain: (1) The accession number for the deposit; (2) The date of the deposit; (3) A description of the deposited biological material sufficient to specifically identify it and to permit examination; and (4) The name and address of the depository.

If a deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his or her signature, stating

- (a) that the deposit has been made under the terms of the Budapest Treaty; **and**
 - (b) that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent,
- would satisfy the deposit requirements. See 37 C.F.R. 1.808.

If a deposit is not made under the terms of the Budapest Treaty, then the requirements may be satisfied by an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or by a statement by an attorney of record over his or her signature, stating that the deposit has been made at an acceptable depository and establishing that the following criteria have been met:

- (a) during the pendency of the application, access to the deposit will be afforded to one determined by the Commissioner to be entitled thereto;
- (b) all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent;
- (c) the deposit will be maintained for a term of at least thirty (30) years and at least five (5) years after the most recent request for the furnishing of a sample of the deposited material;

Art Unit: 1646

(d) a viability statement in accordance with the provisions of 37 C.F.R. 1.807 is provided; and

(e) the deposit will be replaced should it become necessary due to inviability, contamination, or loss of capability to function described in the manner in the specification.

In either case, the identifying information set forth in 37 C.F.R. 1.809(d) should be added to the specification if it is not already present. For deposits made with the ATCC, note that effective 23 March 1988 the depository's address is:

American Type Culture Collection
10801 University Boulevard
Manassas, VA 20110-2209

See 37 C.F.R. 1.803-1.809 for additional explanation of these requirements.

Art:

The art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goli et al. (US 6,130,325, provided by applicants) discloses a novel p24 vesicle protein (SEQ ID NO:3), which sequence is 99.5% identical to SEQ ID NO:2 of the present invention (see computer printout of the search results).

Conclusion:

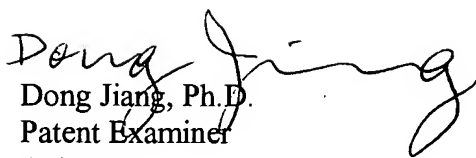
Claims 1-16 and 19-41 are allowable.

Art Unit: 1646

Advisory Information:

Any inquiry concerning this communication should be directed to Dong Jiang whose telephone number is 571-272-0872. The examiner can normally be reached on Monday - Friday from 9:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nickol, can be reached on 571-272-0835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Dong Jiang, Ph.D.
Patent Examiner

AU1646

10/18/06